



16 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Schlumberger Technology Corporation
IP Dept., Well Stimulation
110 Schlumberger Drive, MD1
Sugar Land, TX 77478

In re Application of JOHNSON et al. :
Application No.: 09/980,463 :
PCT No.: PCT/EP99/03946 :
Int. Filing: 03 June 1999 :
Priority Date: None : DECISION ON PETITION
Attorney Docket No.: 55.0206PCT : UNDER 37 CFR 1.47(a)
For: SHEAR-SENSITIVE PLUGGING FLUID :
FOR PLUGGING AND A METHOD FOR :
PLUGGING A SUBTERRANEAN :
FORMATION ZONE :

This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 11 December 2002.

BACKGROUND

On 17 June 2002, in response to the Notification of Missing Requirements mailed on 08 January 2002, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signatures of inventors, Kamal Arsanious and Allen R. Toney. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicant, Les Johnson, David Quinn and Patrick Murphy on behalf of Kamal Arsanious and Allen R. Toney and a statement of facts under 37 CFR 1.47(a).

On 11 October 2002, a decision dismissing the petition was mailed to applicant indicating that applicant had not provided sufficient factual proof that the non-signing joint inventors refused to execute the application or could not be reached after diligent effort. On 11 December 2002, applicant filed the instant renewed petition accompanied by a declaration executed by previous nonsigning inventor Kamal Arsanious. Applicant continues to allege that Allen R. Toney is uncooperative and that his conduct constitutes a refusal to sign.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3) and (4) have been previously satisfied. With regard to Item (2), when it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted.

With the petition, petitioner provided a statement from Carmen Delgado, dated 03 December 2002, which explains that she sent copies of the specification and claims for the present application to inventor Toney when she sent (1) a copy of the International Application PCT/EP99/03926 on 16 June 1999 and (2) a copy of the publication of this application on 28 December 2000. Ms. Delgado concludes that Mr. Toney was already in possession of a copy of the specification and claims when she sent letters on 18 December 2001, 17 January 2002 and 12 February 2002 "requesting [his] signature on the application documents". Ms. Delgado further confirms that a copy of the declaration was sent to inventor Toney with her letter sent on 12 February 2002. Mr. Toney signed for the documents delivered on 21 February 2002 as indicated by the postal delivery notice included with the petition.

In addition, counsel states that he spoke to Mr. Toney by telephone on two occasions, 03 May and 09 May 2002 at which time Mr. Toney stated that he would sign and send the forms to counsel. As of the date of the petition, these documents were not returned to counsel. Under these circumstances, it can now be concluded that Mr. Toney's conduct and uncooperativeness constitutes his refusal to sign the application.

The evidence submitted now supports a finding that the nonsigning inventor by his conduct refuses to sign the application for the reasons set forth above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declarations filed 17 June 2002 and 11 December 2002 and to mail a filing receipt. The application has an international filing date of 03 June 1999 under 35 U.S.C. 363, and a date of 11 December 2002 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be

forwarded to the non-signing inventor at his last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.



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Priority Date: None :
Attorney Docket No.: 55.0206PCT :
For: SHEAR-SENSITIVE PLUGGING FLUID :
FOR PLUGGING AND A METHOD FOR :
PLUGGING A SUBTERRANEAN FORMATION ZONE :

Dear Mr. Toney:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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